

REMARKS

Claims 2-4, 6 and 8-18 and 21 have been pending.

Claims 4, 8-15 and 21 are rejected under 35 USC 102(b) as being anticipated by Voit (US Patent No. 5,825,862).

Claims 2-3, 6 and 16 are rejected under 35 USC 103(a) as being unpatentable over Voit in view of Palmer (US Publication no. 2001/0038690).

Claims 17-18 are rejected under 35 USC 103(a) as being unpatentable over Voit in view of Kauffman (US Patent No. 5,003,591).

Claims 4, 9, and 21 are amended, new claims 23-26 are added, and, thus, claims 2-4, 6, 8-18, 21 and 23-26 remain pending for reconsideration, which is respectfully requested.

No new matter has been added in this Amendment.

REJECTIONS

In the previous Office Action independent claims 4, 9 and 21 were deemed allowable over Voit and Palmer and independent claims 19, 20 and 22 were rejected over Voit and Palmer. Therefore, allowance of independent claims 4, 9 and 21 has been withdrawn and these claims are now anticipatorily rejected over Voit.

The rejected independent claims are 4, 9 and 21.

To reject the independent claims 4, 9 and 21, the Office Action relies on FIG. 3 and column 9, line 56 to column 10, line 25 and column 11, lines 5-36. See also, FIG. 1, SSP 11, ISCP 15, and DET 25, column 5, lines 9-15 and column 11, lines 53-65 and column 12, lines 62-67.

The independent claims are amended in view of dependent claim 14 and paragraphs 30-31 and 55 of the present Application. In rejecting dependent claim 14, the Office Action in page 5 relies on Voit, column 11, lines 33-44. However, Voit in column 11, lines 5-36 and column 12, lines 14-34 discusses "completing the call," but fails to disclose or suggest any details of how the call is completed. In contrast to Voit, the claimed present invention enables completing the call "**directly**" at the entertainment system call manager 24. In other words, Voit fails to disclose or suggest the DET 25 completing a call. Support for the claim amendments can also be found, for example, in FIGS. 2 and 4 of the present Application.

Further in rejecting dependent claim 15, the Office Action in page 5 relies on Voit, column 10, lines 26-33, which discusses:

Preferably, the DET or other broadband terminating device of the CPE quickly returns an automated response. The query and response may be very simple, such as whether or not a video event is in progress. When the response is received by ISCP 15, it then sends a TCAP response message to the SSP (Step S8) and the SSP processes the narrowband call in accordance with the response message (Step S9).

However, the SSP processes the narrowband call in accordance with the response message by routing the call to a user's telephone and not to the DET 25 as suggested by Voit's FIG. 1 and column 9, lines 44-54, which discuss:

Although shown as separate elements in FIG. 1, it should be understood that there may be some physical or virtual connection or relationship between the narrowband network including SSP 11 and STP 13 and broadband network 21. For example, broadband network 21 could receive broadband source information from SSP 11 through a T1 line or other broadband connection, or the DET 25 of customer A could be connected to and receive video information over the same telephone line from SSP 11 providing standard telephone service. Similarly, interface point 17 could be provided in DET 25 by appropriate software resident in the DET.

See also, column 9, lines 1-43. It is readily apparent that this Voit discussion fails to disclose or suggest the claimed present invention's, "taking the held call directly at the entertainment system call manager, or sending the held call by the entertainment system call manager to a user voice mail at the user's premise, or both, according to the held call handling option selected by the user." Accordingly, in contrast to Voit the claimed present invention as recited in dependent claims 14 and 15 provides:

14. (PREVIOUSLY PRESENTED) The call management system as claimed in claim 9, wherein ***if the selected call handling option is to take the call, the telephony-network-resident call management server forwards the call via the telephony network to the television call manager of the subscriber entertainment system.***

15. (PREVIOUSLY PRESENTED) The call management system as claimed in claim 14, wherein the held call at the telephony-network-resident call management server ***is answered via the telephony network through the subscriber entertainment system.***

Voit fails to disclose or suggest ***answering a call over the telephony network*** at the

DET 25. Voit cannot anticipate at least dependent claims 14 and 15, because Voit fails to disclose or suggest every element of dependent claims 14 and 15, and, thus, dependent claims 14 and 15 should be allowable.

More particularly, in contrast to Voit, the claimed present invention as recited in independent claims 4, 9 and 21, using claim 4 as an example, provides:

4. (CURRENTLY AMENDED) A method of managing calls through an entertainment system, comprising:

notifying by an entertainment system call manager, via a data network, a call management server residing in a telephony provider network to monitor calls on the telephony provider network for the entertainment system;

holding in the telephony-network-resident call management server a call on the telephony provider network for the entertainment system prior to routing the call to the entertainment system, in response to the notifying;

receiving in the entertainment system call manager a held call signal indicating a held call, during a program play by the entertainment system to a user, via the data network from the telephony-network-resident call management server;

presenting by the call manager a selectable call handling option chosen from a group comprising one or more of take the call, send the call to voice mail, forward the call to another number, play a message, ignore the call, and reject the call, in response to the held call signal through the entertainment system during the program play; and

handling the held call according to a call handling option selected by the user through the entertainment system and provided via the data network to the telephony-network-resident call management server, and

taking the held call directly at the entertainment system call manager, or sending the held call by the entertainment system call manager to a user voice mail at the user's premise, or both, according to the held call handling option selected by the user.

New independent claim 26 reinstates previously cancelled independent claim 19, as further amended along the lines of forgoing amended independent claims and new dependent claims to provide an alternative recitation of the present invention, and is allowable at least for the same allowability rationale for independent claims 4, 9, and 21. In contrast to Voit and Palmer, the claimed present invention as recited in new independent claim 26 provides:

26. (NEW) A method, comprising:

providing a telephony-network-resident call management server to hold a call on the telephony provider network prior to routing the call to a user's premise;

providing a call manager communicably connected to an entertainment system at the user's premise, which processes data, including an audio and/or video program, to perform a process comprising:

to notify, via a data network, the call management server residing in the telephony provider network to monitor and hold a call on the telephony network for the user prior to routing the call to the user's premise,

to receive a held call signal indicating a held call, during a program play by the entertainment system to the user, via the data network from the telephony-network-resident call management server,

to automatically pause and record the program played through the entertainment system when the held call signal is received by wirelessly controlling a buffer at the user's premise,

to present through the entertainment system a selectable call handling option chosen from a group comprising one or more of take the call, send the call to voice mail, forward the call to another number, play a message, ignore the call, and reject the call, *in response to the held call signal through the entertainment system during the program play,*

to handle the held call according to a call handling option selected by the user through the entertainment system and provided via the data network to the telephony-network-resident call management server,

to take the held call, or to send the held call to a user voice mail at the user's premise, or both, directly at the call manager according to the call handling option selected by the user, and

to resume playing the program when the held call at the telephony-network-resident call management server is terminated.

DEPENDENT CLAIMS

Dependent claims are patentably distinguishing over the relied upon references, because they recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependencies from the independent claims 4, 9 and 21.

Dependent claims 2-3, 6 and 16:

For example, to reject dependent claims 2-3, 6, and 16 relating to buffering a program played through the entertainment system while a held call signal is received, the Office Action also relies on Palmer. MPEP 706.02(j) sets forth a guideline on the contents of a rejection under §103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143-2143.03 for decisions pertinent to each of these criteria." Factual findings in support of a *prima facie* case of obviousness must be supported by substantial evidence. *In re Zurko*, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001).

In rejecting dependent claims 2 and 6, the Office Action provides as motivation to modify Voit in view of Palmer, because the "modification of the invention enables the system to buffer the program being played through the entertainment system when the held call signal is received so that the user would resume playback after the call." However, there is no suggestion or motivation in Palmer or Voit to modify Voit to provide the claimed present invention's, "**buffer the program**" while "**holding in the telephony-network-resident call management server a call on the telephony provider network for the entertainment system prior to routing the call to the entertainment system**," because Palmer fails to disclose or suggest anywhere "**holding in the telephony-network-resident call management server a call on the telephony provider network for the entertainment system prior to routing the call to the entertainment system**." Palmer in paragraphs 41 and 52, discusses routing the call to the user's device and pausing the video program (Palmer's paragraph 58 provides, "The "synchronize services" use case 520 manages the simultaneous delivery of voice and video

services to the user”), but Palmer is silent on the claimed present invention’s “***holding in the telephony-network-resident call management server ... prior to routing the call to the entertainment system.***”

A benefit of the claimed invention is that by locating a call management server in the telephony provider network and in communication with a subscriber entertainment system via a data network, a call monitoring system can be provided to efficiently manage calls through the entertainment system by holding calls in the telephony provider network and by enabling the entertainment system to control handling of the held call, including “**taking the held call directly at the entertainment system call manager, or sending the held call by the entertainment system call manager to a user voice mail at the user's premise, or both, according to the held call handling option selected by the user**” (e.g., independent claim 4) and including “**buffering** the program being played through the entertainment system when **the held call signal** is received” (e.g., dependent claim 2). In other words, Palmer, and clearly Voit, fail to disclose or suggest “**buffering ... when the held call signal** is received,” because Palmer does not hold calls and Voit is silent on any type of program buffering as part of the call handling options discussed by Voit, for example, in column 1, lines 5-23. The Office Action is improperly using the claimed present invention’s advantage or benefit in hindsight as motivation evidence to modify Voit in view of Palmer. In other words, the Office Action is using the teaching or suggestion of **buffering a program while a call is held** at the telephony provider network prior to routing the call to the user, based upon the Applicant’s disclosure, which is not proper, because such teaching or suggestion is not found in Voit or Palmer. See W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”). It would not have been obvious at the time the claimed present invention was made to provide a method and system of “**holding in the telephony-network-resident call management server ... prior to routing the call to the entertainment system**” and “**taking the held call directly at the entertainment system call manager, or sending the held call by the entertainment system call manager to a user voice mail at the user's premise, or both, according to the held call handling option selected by the user**” (e.g., independent claim 4) and including “**buffering** the program being played through the entertainment system when **the held call signal** is received” (e.g., dependent claim 2).

Accordingly, at least dependent claims 2-3, 6, and 16 are nonobvious over Voit and Palmer.

New dependent claims 23, 24, and 25:

New dependent claims 23 and 24 are added relating to buffering a program emphasizing that the claimed present invention's television call manager **wirelessly** controls a program buffer at the customer's premise to buffer a program played through the entertainment system "**when a held call signal** is received." Although Palmer, in paragraph 63, discusses recording a broadcast video program when receiving a telephone call, Palmer fails to disclose or suggest the set top box 135 wirelessly controlling the digital VCR. Therefore, in contrast to Voit and Palmer, the claimed present invention as recited in dependent claims 23 and 24, using dependent claim 23 as an example provides:

23. (NEW) A method according to claim 2, wherein the buffering comprises **wirelessly controlling by the entertainment system call manager a program buffer at a premise of the user to buffer the program.**

Support for the new dependent claims 23 and 24 can be found, for example, in paragraph 27 and FIGS. 1-4 of the present Application.

The newly added dependent claim 25 is directed to the call manager 24 of the present invention, which in contrast to Voit and Palmer provides:

25. (NEW) A system according to claim 9, wherein the television call manager comprises:

**a telephone to directly take the held call; and
an audio and/or video processor to process input audio and/or video data from the telephone and/or from a broadcast center for the subscriber entertainment system.**

Support for new dependent claim 25 can be found, for example, in FIG. 4 of the present Application.

Accordingly, at least dependent claims 23, 24 and 25 are allowable over Voit and Palmer.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,
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Date: October 27, 2005

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